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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/656,076	09/04/2003	Geoffrey B. Rhoads	P0876	8345

23735 7590 12/14/2004
DIGIMARC CORPORATION
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EXAMINER

JOHNS, ANDREW W

ART UNIT PAPER NUMBER

2621

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/656,076

Applicant(s)

RHOADS

Examiner

Andrew W. Johns

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>9/17/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. § 120 as follows: The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application); the disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. § 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The legal criteria for the “written description” requirement is laid out in M.P.E.P. § 2163, as well as the *Guidelines for Examiner of Patent Applications Under the 35 U.S.C. § 112, first paragraph, “Written Description” Requirement*, published in the Federal Register, Vol. 66, No. 4, January 5, 2001.

“[T]he test for sufficiency of support...is whether the disclosure of the application relied upon ‘reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter.’” *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575; 227 USPQ 177, 179 (Fed. Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375; 217 USPQ 1089, 1096 (Fed. Cir. 1983)). “Although [the applicant] does not have to describe exactly the subject matter claimed,...the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.” *Vas-Cath*, 19 USPQ2d at 1116 (quoting *Gostelli*, 872 F.2d 1008, 1012; 10 USPQ2d 1614, 1618 (Fed. Cir. 1989)). It is “not a question of whether one skilled in the art might be able to construct the patentee’s device from the teachings of the disclosure...Rather, it is a question whether the application necessarily discloses that

particular device.” (*Jepson v. Coleman*, 314 F.2d 533, 536; 136 USPQ 647, 649-50 (CCPA 1963)). “The question is not whether a claimed invention is an obvious variant of that which is disclosed in the specification. Rather, [the] application itself must describe an invention, and do so in sufficient detail that one skilled in the art can clearly conclude that the inventor invented the claimed invention as of the filing date sought” *Lockwood v. American Airlines Inc.* 41 USPQ2d 1961 at 1966 (Fed. Cir. 1997).

The claims in the instant application variously include limitations that are not described in the priority application(s)¹, as originally filed, in sufficient detail that one skilled in the art can clearly conclude that applicant invented the application as of the filing date of the priority application(s). Specifically, claim 1 requires using first information in a first position of a *digital* representation of an object to produce authentication information (lines 3-4) that is incorporated into a second portion of the digital representation (lines 6-7). However, the disclosure in the priority documents does not describe using first information in a first portion of the digital representation to produce first authentication information. The specification does state that the information encoded into the digitized photograph (i.e., the second portion of the digital representation) “may correlate to, or be redundant with readable information appearing on the document” (page 72, lines 8-9), but there is no discussion of any digital representation of this readable information that would correspond to the claimed “first portion of the digital representation,” and the specification does not describe how the encoded information is obtained. While one of ordinary skill in the art might find it obvious to obtain the encoded information

¹ i.e., Application S.N. 08/512,993 filed 09 August 1995, which applicant has pointed to as providing support for the invention now claimed. The specification of the ‘993 application, as well as the intervening applications is substantially identical to the specification of the instant application. However, the subject matter of the instant claims has not been presented prior to the presentation of the instant claims on the filing date of the instant application (i.e., 04 September 2003).

from a digital representation of the “readable information appearing on the document” in view of this description, the encoded information doesn’t *necessarily* have to be obtained this way (for example the encoded information could be obtained from a common database also used to create the readable information on the document, which would provide the described correlation
5 between the encoded information and the readable information). Therefore, the disclosure, as originally filed in the priority application(s), fails to describe each and every feature of the invention defined in claim 1, and fails to demonstrate that applicant was “in possession” of the subject matter of claim 1 at the time of the filing of the various priority documents.

Furthermore, a number of the dependent claims include additional limitations that are
10 likewise not adequately described by the disclosure. Specifically, claim 2 requires that the first portion be certain more significant components of data items, while the second portion be certain less significant portions of the data items. Claims 3 and 4 variously further define these data items as pixels or signal samples. However, nothing in the disclosure suggests using information in certain more significant components of data items to produce authentication information
15 which is subsequently incorporated into certain less significant portions, as stipulated by claim 2. While the specification does define the use of pixels and signal samples, there is no suggestion that the information in the more significant bits of this pixels or signal samples be used to produce authentication information that is then incorporated into less significant bits of the pixels or signal samples, as required by the claims. Similarly, while the disclosure does discuss
20 documents and images, there is no discussion of document and image “layers” or that the first portion be a “document layer” and the second portion be an “image layer,” as further required by claims 6 and 9. Finally, claims 7-10 variously define the first portion as being “vector data”, “content codes” or “metadata”. While the specification might describe vector data or content

codes, and includes information that might be construed as being “metadata,” there is do
description in the specification that information in any vector data, content codes or metadata be
used to produce the authentication information incorporated into the second portion (which
appears to correspond to the digitized photograph). Because none of these additional limitations
5 is described in the specification, the disclosure, as originally filed in the priority application(s),
fails to adequately show that applicant possessed the invention now claimed at the time the
various priority documents were filed.

At best, the disclosure provides for the incorporation of authentication information that
correlates with, or is redundant to, information in other portions of the document, but fails to
10 define this authentication information as being produced using information from other portions
in the digital representation of the document. While a number of the claimed limitations might
have been obvious to one of ordinary skill in the art, this is not sufficient to demonstrate
possession of the claimed invention because these limitations are not *necessarily* required by the
disclosure in the priority application(s). “One shows that one is ‘in possession’ of *the invention*
15 by describing *the invention*, with all its claimed limitations, not that which makes it obvious.”
Lockwood v. American Airlines Inc. 41 USPQ2d 1961 at 1966 (Fed. Cir. 1997) (emphasis in
original). Although the invention is not required to be described using the exact same terms, “the
specification must contain an equivalent description of the claimed subject matter. A description
which renders obvious the invention for which an earlier filing date is sought is not sufficient.”
20 *Lockwood v. American Airlines Inc.* 41 USPQ2d 1961 at 1966 (Fed. Cir. 1997). “It is not
sufficient for purposes of the written description requirement of Section 112 that the disclosure,
when combined with the knowledge in the art, would lead one to speculate as to modifications
that the inventor might have envisioned, but failed to disclose. Each application in the chain

must describe the claimed features.” *Lockwood v. American Airlines Inc.* 41 USPQ2d 1961 at 1966 (Fed. Cir. 1997). Since the priority application(s) do not describe or necessarily require the various claim limitations addressed in more detail above, the priority application(s) do not adequately describe the invention, as now claimed, so that one of ordinary skill in the art would recognize that applicant was in possession of the claimed invention as of the filing date(s) of these priority application(s). Therefore, the claimed invention is only entitled to the filing date of the instant application, where these claims were first presented (i.e., 04 September 2003).

Claim Rejections - 35 U.S.C. § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-10 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Zhao et al. ‘301 (US 6,487,301 B1).

As pointed out more fully above, applicant has not complied with the conditions for receiving the benefit of the claimed priority filing date(s) because the disclosure is not sufficient to comply with the requirements of 35 U.S.C. § 112, first paragraph. Therefore, the effective filing date for the invention defined by claims 1-10 is 04 September 2003, and Zhao et al. ‘301 qualifies as prior art under 35 U.S.C. § 102(e). Furthermore, because claims 1-10 of the instant application were specifically identified by applicant as corresponding identically to claims 1-4 and 6-11 of Zhao et al. ‘301, the instant claims are clearly anticipated by Zhao et al. ‘301.

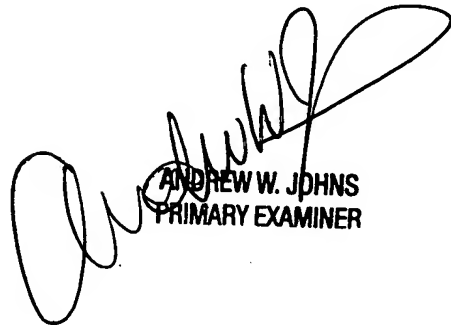
Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Johns whose telephone number is (703) 305-4788. The examiner is normally available Monday through Friday, at least during the hours of 9:00 am to 3:00 pm Eastern Time. The examiner may also be contacted by e-mail using the address: andrew.johns@uspto.gov. (Applicant is reminded of the Office policy regarding e-mail communications. See M.P.E.P. § 502.03)

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Leo Boudreau, can be reached on (703) 305-4706. The fax phone number for this art unit is (703) 872-9306. In order to ensure prompt delivery to the examiner, all unofficial communications should be clearly labeled as "Draft" or "Unofficial."

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center Receptionist whose telephone number is (703) 305-4700.

A. Johns
3 December 2004



ANDREW W. JOHNS
PRIMARY EXAMINER